

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1, 6, 7 and 10 are rejected under 35 U.S.C 102 (b) over the patent to Schwarz.

Claim 8 is rejected under 35 U.S.C. 102(b) over the patent to Kokami.

Claims 3-5 are rejected under 35 U.S.C. 103(a) over the patent to Schwarz in view of the applicant's admission of prior art.

Also, the specification and the drawings are objected to and claims 7 is rejected under 35 U.S.C. 112.

In connection with the Examiner's formal objections and rejections, applicants have cancelled claims 7-10 and it is believed that the Examiner's grounds for formal objections and rejections of the drawings and the specification of claim 7 should be considered as no longer tenable and should be withdrawn.

After carefully considering the Examiner's rejection of the claims over the art, applicant has also canceled claims 3 and 5 and amended claim 1 by incorporating into it the features of these canceled claims.

Claim 1 has been amended to incorporate the phase branches including a non-selected phase branch with a transistor element at the reference potential during an evaluation phase of a phase branch, and each phase branch is provided with the transistor element in one of the resistors producing a voltage drop.

These new features of the present invention are not disclosed either in the patent to Schwarz or the patent to Kokami.

The Examiner rejected the original claims over this reference as anticipated. In connection it is believed to be advisable to cite the decision in re Lindenmann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the references do not disclose each and every element of claim 1 as amended, in their specific order, as well as in their interaction and interjunction.

Therefore, it is believed that the Examiner's rejection of the original claims as being anticipated should be considered as no longer tenable with respect to claim 1 and should be withdrawn.

As for the Examiner's rejection of original claims as obvious over the patent to Schwarz in view of the applicant's admission of prior art, it is first of all respectfully submitted that the combination proposed by the references can not be considered as obvious. In order to support the valid combination rejection, the references must contain a hint or suggestion for such combination. In connection with this, it is believed to be advisable to submit the decision in re Fritch, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992) in which it was stated:

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification."

It is believed that this decision is clearly applicable to this case.

Also, it should be mentioned that in order to arrive at the applicant's invention from the prior art applied by the Examiner, the references have to be fundamentally modified. However, it is known that in order to arrive at a claimed invention, by modifying the references cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in *re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggestion; it is not a proper use of a patent as a reference to modify its structural to one which prior art references do not suggest.

Definitely, the references do not contain any hint or suggestion for such modifications.

In view of the above presented remarks and amendments, it is believed that claim 1 as amended should be considered as patentably distinguishing over the prior art and should be allowed.

As for the dependent claims, these claims depend on claim 1, they share its presumably allowable features, and therefore it is respectfully submitted that they should be allowed.

Reconsideration and allowance of the present application is
most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal aspects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned at (631-549-4700).

Respectfully submitted,



Michael J. Striker
Attorney for Applicants
Reg. No. 27233